

REMARKS

Claims 1 through 12 are pending in this Application, of which claims 7 through 12 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1 through 6 are active.

Claims 1, 3 and 4 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 1 through 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Minamino et al.

In the statement of the rejection the Examiner referred to Fig. 11A, asserting the disclosure of an optical module which admittedly falls short of comprising a semiconductor material as in the claimed invention. Rather than cite objective evidence, the Examiner took official notice that the utilization of a semiconductor device for an optical module for high speed is old and well known. The Examiner, therefore, concluded that one having ordinary skill in the art would have been motivated to modify the device disclosed by Minamino et al. to include a semiconductor optical module for high speed. This rejection is traversed.

Firstly, what may or may not be known in **general** does not necessarily provide the requisite realistic motivation to modify a **specific** semiconductor device, in this case the **specific** device disclosed by Minamino et al., to arrive at the now claimed invention. See, for example, *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Indeed, as recently held by the Court of Appeals for the Federal Circuit in *Teleflex Inc. v. Ficosa North America Corp.*, 299

F.3d 1313, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002), regardless of the source of motivation, **factual** evidence must be provided. **No** such **factual** evidence has been provided to support the Examiner's motivation. Accordingly, a *prima facie* case under 35 USC §103 has not been made.

Leaving aside the semiconductor material issue, there are significant differences between the optical module defined in independent claim 1 and the module disclosed by Minamino et al. that undermine the Examiner's obviousness conclusion. Specifically, Fig. 11A of Minamino et al. illustrates an optical subassembly (10), a housing including a base (13) and a cover (12), a support (5) and a thermal sheet provided between the cover (12) and the support (5). But the optical module disclosed by Minamino et al. relates to pluggable receptacle modules. Pluggable receptacle modules are quite different from the optical module defined in independent claim 1 and the claims dependent thereon.

The Examiner reads receptacle (5) in Fig. 11A as a support. But receptacle (5) of the particular module illustrated in Fig. 11A of Minamino et al. is quite **different** from the support element of the claimed invention, as one having ordinary skill in the art would have understood. This is because receptacle (5) of the module disclosed by Minamino et al. has a **slit** which facilitates the connection with optical subassembly (10). If a force is applied to the top or bottom of the receptacle, then receptacle (5) would easily **deform** causing optical **misalignment** between the optical module (10) and the connector in receptacle (5).

The Examiner interpreted cover (6) in the Fig. 11A module of Minamino et al. as a thermal sheet. But cover (6) is **different** from the thermal sheet of the claimed module, as one having ordinary skill in the art would have understood. This is because the applied force would deform the assembly of receptacle (5), cover (6) and optical module (10), to cause optical misalignment between optical module (10) and the connector in receptacle (5). The combination

of receptacle (5) and cover (6) cannot provide an assembly with the strength necessary to resist deformation.

Receptacle (5) of the module disclosed by Minamino et al. aligns optical module (10) with the connector in receptacle (5). But the support element of independent claim 1 of the present Application is in **contact** with the subassembly and reduces stress applied to the optical subassembly from the thermal sheet, and provides a thermal path for the optical subassembly.

Further, Applicant separately argues the patentability of **claim 2**, because the receptacle (5) of Minamino et al. does not have a leg and a bridge as required by claim 2.

Based upon the foregoing it should be apparent that there are fundamental differences between the optical module of the claimed invention and the optical module disclosed by Minamino et al. There is **no** apparent **factual** basis to support the conclusion that one having ordinary skill in the art would somehow have been realistically motivated to dramatically modify the module disclosed by Minamino et al. to arrive at the claimed invention absent, of course, improper reliance upon Applicant's disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).


Applicant, therefore, submits that the imposed rejection of claims 1 through 6 under 35 U.S.C. § 103 for obviousness predicated upon Minamino et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Application No.: 10/717,908

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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